JUDGMENT OF THE COURT OF FIRST INSTANCE (Fifth Chamber)

21 February 2006 *

In Case T-214/04,

The Royal County of Berkshire Polo Club Ltd, established in Winkfield, Windsor, Berkshire (United Kingdom), represented by J. Maitland-Walker, Solicitor, and D. McFarland, Barrister,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by P. Bullock, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervening before the Court of First Instance, being

* Language of the case: English.

The Polo/Lauren Co. LP, established in New York (United States), represented by P. Taylor, Solicitor, and A. Bryson, Barrister,

ACTION brought against the decision of the First Board of Appeal of OHIM of 25 March 2004 (Case R 273/2002-1), relating to opposition proceedings between The Polo/Lauren Co. LP and The Royal County of Berkshire Polo Club Ltd,

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Fifth Chamber),

composed of M. Vilaras, President, E. Martins Ribeiro and K. Jürimäe, Judges,

Registrar: K. Andová, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 3 June 2004,

having regard to the response lodged at the Court Registry on 29 September 2004,

having regard to the intervener's response lodged at the Court Registry on 21 September 2004,

further to the hearing on 15 September 2005,

gives the following

Judgment

Background to the dispute

1 On 5 June 1997, The Royal County of Berkshire Polo Club Ltd (hereinafter 'the applicant') filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

2 The trade mark applied for is a mixed sign containing a verbal element and a figurative element, reproduced below:



3 The goods covered by the trade mark applied for are in Classes 3, 9, 14, 18, 21 and 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The goods are in Class 3 and correspond to the following description:

'Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions, dentifrices; aftershave, preparations for hair, shampoo, deodorants, eau de toilette, body sprays, bath oils, bubble bath, shower gel'.

4 The application for registration of the Community trade mark was published in the *Community Trade Marks Bulletin* No 92/1998 of 30 November 1998.

5 On 8 January 1999, The Polo/Lauren Company LP (hereinafter 'the intervener') filed a notice of opposition, under Article 42(1) of Regulation No 40/94. The ground relied upon in support of the opposition was the likelihood of confusion, referred to in Article 8(1)(b) of Regulation No 40/94, between the mark sought and the earlier national trade marks owned by the intervener. The earlier marks in question are the following:

(a) German trade mark No 1 153 949 filed on 30 January 1988, registered on 9 February 1990 and protected until 31 January 2008 for the following goods in Class 3: 'perfumes, eau de Cologne, toilet water, cosmetics, particularly powders, creams, lotions, essential oils, soaps, cosmetic preparations having deodorising additives, but excluding hair cosmetics';

(b) Greek trade mark No 103 778 filed on 23 April 1991 and registered on 17 March 1994 for all goods in Class 3, including 'perfumery, cologne, toilet water, cosmetics, powder, creams, lotions, essential oils, soaps, deodorants for personal use, hair lotions, dentifrices';

(c) Spanish trade mark No 1 253 471 filed on 19 May 1988 and registered on 5 November 1990 for a range of goods in Class 3, namely: 'perfumery, cologne, toilet water, cosmetics, powder, creams and lotions, essential oils, soaps and deodorants for personal use, not including dentifrices and preparations for cleaning teeth';

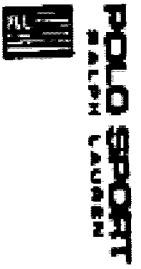
(d) Swedish trade mark No 225 475 filed on 4 July 1989 and registered on 2 August 1991 for goods in Class 3, namely: 'perfumery, eau de Cologne, toilet water, cosmetics, powder, creams and lotions, essential oils, soaps, deodorants for personal use'.

The sign registered for those four trade marks was the following:



(e) Two United Kingdom registrations of the word mark **POLO** Nos 638 708 and 657 863 filed on 18 July 1945 and 1 April 1947 respectively and renewed until 18 July 2008 and 1 April 2006 for a range of goods in Class 3, namely: 'perfumery, toilet preparations (not medicated), cosmetic preparations, dentifrices, depilatory preparations, soaps, toilet articles (not included in other Classes), but not including powder boxes and not including any goods of the same description as powder boxes' (No 638 708) and 'bath salts, talcum powder, face powder, face cream, scalp stimulating preparations, lotions for use after shaving, all being non-medicated toilet preparations; and lipstick, brilliantine, hair lotions, shampoos, dentifrices, soaps and perfumes' (No 657 863);

(f) United Kingdom figurative trade mark No 2 007 609:



filed on 23 December 1994 and registered on 13 March 1996 for a range of goods in Class 3, namely: 'soaps, perfumery, toilet water, essential oils, cosmetics, dentifrices, cologne, shaving gel, shaving cream, after-shave balm, after-shave mousse, skin lotion, skin cream, face moisturiser, talcum powder, antiperspirant spray and deodorant stick for personal use and sun screen preparations, all for men', but not including hair products;

(g) United Kingdom figurative trade mark No 2 140 409:



filed on 30 July 1997 and registered on 27 February 1998 for a range of goods in Class 3, that is to say: 'perfumes, colognes, fragrances, after-shave lotion, after-shave balm, antiperspirant, personal deodorant, talcum powder, toilet water,

body powder, cosmetics, beauty care products, namely face and body creams, lotions and sun-tanning creams and lotions, and sun protection creams and lotions, products for hair care, namely shampoos, conditioners, hair creams and lotions and brilliantines and scalp-stimulating preparations; products for bath and shower, namely toilet soaps, body shampoos, body scrubs, body smoothers, bath salts, bath and shower gels, bath and shower oils and essential oils';

(h) United Kingdom registration No 657 864 of the figurative trade mark:



filed on 1 April 1947 and renewed on 15 May 1996 for a range of goods in Class 3, namely: 'bath salts, talcum powder, face powder, scalp stimulating preparations, lotions for use after shaving, face cream, all being non-medicated toilet preparations; and lipsticks, brilliantine, hair lotions, shampoos, dentifrices, soaps and perfumes';

(i) United Kingdom registration No 1 484 052 of the figurative mark:



filed on 28 November 1991 and registered on 7 January 1994 for fragrant preparations included in Class 3.

6 By Decision No 182/2002 of 31 January 2002, communicated to the parties that day, the Opposition Division of OHIM rejected the opposition.

7 On 27 March 2002, the intervener filed a notice of appeal before the OHIM, under Article 59 of Regulation No 40/94, against the Opposition Division's decision.

8 By Decision of 25 March 2004 (Case R 273/2002-1), which was notified to the applicant on 1 April 2004 (hereinafter 'the contested decision'), the First Board of Appeal allowed the appeal in part. It found, in essence, that there was a likelihood of confusion between the trade mark applied for and the earlier figurative trade mark

registered in the United Kingdom under No 657 864 for the following goods: 'cleaning preparations, dentifrices, perfumery, aftershave, preparations for hair, shampoo, soaps, essential oils, cosmetics, hair lotion, deodorants, eau de toilette, body sprays, bath oils, bubble bath, shower gel'. On the other hand, according to the Board of Appeal, there was no likelihood of confusion for the following goods: 'bleaching preparations and other substances for laundry use, polishing, scouring and abrasive preparations'.

Forms of order sought by the parties

9 The applicant claims that the Court should :

— set aside the contested decision;

— order the registration of the trade mark for all the classes of goods, including Class 3;

— order OHIM to pay the costs, including those incurred in the proceedings before the Board of Appeal.

10 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

11 The intervener contends that the Court should uphold the opposition in respect of all the goods referred to in the application for registration, including bleaching preparations and other substances for laundry use, and polishing, scouring and abrasive preparations, on the basis both of the earlier trade mark registered in the United Kingdom under No 657 864 and of the other earlier marks.

Law

12 The applicant relies in support of its action, in essence, on two pleas in law alleging breach of, first, the duty to state reasons and, second, Article 8(1)(b) of Regulation No 40/94.

The applicant's first plea in law, alleging breach of the duty to state reasons

Arguments of the parties

13 The applicant takes the view that the contested decision breaches the duty to state reasons. More particularly, the Board of Appeal stated no or no sufficient reasons for rejecting the reasoning followed in the Opposition Division's decision, according to which, first, the consumer eye has more chance of being attracted to the words 'Royal County of Berkshire' because of their position at the top of the mark, and, secondly, the earlier mark POLO refers to the sport in general, while the Community trade mark will identify a specific polo club.

14 OHIM submits that the Board of Appeal did, at paragraph 31 of the contested decision, justify its conclusion that the signs in question are visually similar. As to the conceptual comparison, OHIM points out that the Board of Appeal correctly found that there is some conceptual similarity between the signs, since they both evoke the sport of polo that has nothing to do with the goods concerned. OHIM submits that the Board of Appeal stated the reasons for its departure from the decision of the Opposition Division.

15 The intervener makes no specific observations concerning the argument that the Board of Appeal stated no or no sufficient reasons for rejecting the Opposition Division's reasoning. It none the less supports the Board of Appeal's reasoning.

Findings of the Court

16 It must be noted that according to the first sentence of Article 73 of Regulation No 40/94, decisions of OHIM are to state the reasons on which they are based. That duty has the same effect as that imposed by Article 253 EC (Joined Cases T-124/02 and T-156/02 *Sunrider* v *OHIM — Vitakraft-Werke Wührmann and Friesland Brands* (*VITATASTE* and *METABALANCE 44*) [2004] ECR II-1149, paragraph 72).

17 According to settled case-law, the dual purpose of the duty to state reasons for individual decisions is, first, to allow an interested party to know the justification for the measure so as to enable him to protect his rights and, second, to enable the Community judicature to exercise its power to review the legality of the decision (see *VITATASTE* and *METABALANCE 44*, cited above, paragraph 73 and the case-law there cited). Whether a statement of reasons satisfies those requirements is a question to be assessed with reference not only to its wording but also to its context and the whole body of legal rules governing the matter in question (Case C-122/94 *Commission* v *Council* [1996] ECR I-881, paragraph 29, and Case T-188/98 *Kuijer* v *Council* [2000] ECR II-1959, paragraph 36).

18 Here, the applicant's allegation that there was no or no sufficient statement of reasons must be examined.

19 First of all, as regards the rejection of the reasoning of the Opposition Division according to which the consumer eye has more chance of being attracted to the words 'Royal County of Berkshire' because they overarch the figurative element of

the mark sought, the Court considers, in particular, that the consideration in paragraph 31 of the contested decision, according to which the manner in which the words comprising the verbal element of the sign in question are written significantly strengthens the dominance of the representation of the polo player, enabled the applicant to know for what precise reason the Board of Appeal had not accepted that the verbal element was the dominant element, and consequently, why it had rejected the Opposition Division's reasoning.

20 Next, as regards the Opposition Division's reasoning that the earlier mark POLO refers to the sport in general, whereas the trade mark sought identifies a specific polo club, it must be noted that, contrary to the applicant's argument, that reasoning was not impugned by the Board of Appeal. Indeed, in paragraph 32 of the contested decision, the Board of Appeal expressly confirmed that the words 'Royal County of Berkshire Polo Club' could evoke for an English consumer a specific club where people play polo.

21 Since, overall, the grounds of the contested decision make clear the reasoning followed as to the assessment of the likelihood of confusion, the first plea in law must be rejected as unfounded.

The applicant's second plea in law, alleging infringement of Article 8(1)(b) of Regulation No 40/94

Arguments of the parties

22 The applicant relies upon several arguments which amount, in essence, to pleading breach of Article 8(1)(b) of Regulation No 40/94.

23 The applicant points out, first, that the contested decision improperly deconstructed the trade mark sought and considered it not as a whole, but as a series of elements to which it ascribed various values of distinctiveness or remarkability.

24 Secondly, the applicant challenges the Board of Appeal's decision in that it decided that none of the words of the verbal element of the sign, 'Royal County of Berkshire Polo Club', was more prominent than the sign's figurative element, namely the roundel device of a polo-playing horseman. Such a conclusion ignores the equal prominence of the words and the figurative element. In that regard, the words are, here, visible and clearly eye-catching by their size, layout and clear block font style. The Board of Appeal therefore erred in considering the figurative element to be the dominant and memorable part of the sign.

25 Thirdly, the applicant criticises the reference, in the contested decision, to the arbitrary nature of the mark sought. According to the applicant that reference ignores the fact that it is a mark of origin, that is to say identifying those goods as originating from The Royal County of Berkshire Polo Club.

26 Fourthly, the applicant maintains that if the contested decision is not set aside, an unfair and unjustifiable monopoly will be created for the intervener over the figurative element of the polo-playing horseman. According to the applicant, that would be incorrect and unacceptable, particularly in view of the number of registrations of trade marks for goods in Class 3 which have been obtained by other polo clubs. In that regard, the applicant refers to the registration of United Kingdom mark No 1 558 682 and Community mark No 980 995.

27 Fifthly, the Board of Appeal made an error of law in that it effectively applied a test wherein the assumed degree of similarity between the marks in question was a substitute for the proper test of likelihood of confusion, namely the taking into account of all the factors of the case.

28 OHIM observes, first, that the Board of Appeal, although it considered the mark sought as a whole, correctly stated that the device of the polo player was the dominant element from the visual point of view. It submits that the Board of Appeal considered that, although there were some differences between the signs, they were not sufficient to outweigh the similarities, especially bearing in mind the principle of the consumer's imperfect recollection. OHIM concludes that the applicant's argument that the Board did not consider the mark sought as a whole is manifestly unfounded. According to OHIM, the Board of Appeal did not unduly emphasise the horseman logo by singling it out and did not, as a result, indulge in an excessive analysis of the signs.

29 Secondly, OHIM submits, the Board of Appeal correctly referred to the arbitrariness of the device of a polo-playing horseman for the goods concerned in Class 3. In that regard the applicant's reasoning in respect of a mark of origin could be accepted if the trade mark sought had only been applied for in respect of services in Class 41, that is to say, sporting activities or activities of a polo club.

30 Thirdly, OHIM submits that the contested decision does not confer on the intervener an unfair and unjustifiable monopoly of the device of a polo player. It takes the view that the Board was entirely correct in stating that the device of a polo-playing horseman is intrinsically highly distinctive in relation to the Class 3 goods

covered by the earlier UK registration, because it is an image with high imaginative content. There is no doubt, submits OHIM, that such a device is arbitrary for the goods in question and deserves to be protected against subsequent applications depicting confusingly similar devices. In the present case, it maintains, the acquired distinctiveness of the earlier trade mark is another factor which justifies protecting it against a later mark featuring, as its dominant element, a similar polo player device. As to the applicant's reference to registrations obtained by other polo clubs for goods in Class 3, OHIM makes clear that in the case of UK trade mark No 1 558 682 registration was allowed following consent by the owner of UK trade mark No 657 864, the intervener in the present proceedings. As to Community trade mark No 980 995, OHIM maintains that the Board observed, in its decision, that it depicts two polo players.

31 Fourthly, OHIM submits that the Board did not err in law in that it substituted for the test of likelihood of confusion a test based on the assumed degree of similarity between the signs. OHIM argues, in that regard, that the existence of a likelihood of confusion was correctly established by the Board of Appeal, since it took into account in its analysis all the factors relevant to the circumstances of the case, namely the partial identity or similarity of the goods, the visual and conceptual similarities between the signs, the enhanced distinctiveness, both inherent and acquired by use, of the polo player device in the intervener's earlier trade marks, and, finally, the existence of a family of trade marks linked to the concept of polo for goods in Class 3.

32 The intervener points out, first, that the visual impression conveyed by the picture of the horseman is much more striking and memorable than the verbal element of the mark. In the first place, the word element is ancillary because it consists of six words in relatively small type which are particularly difficult to read as they are in the form of a roundel. Also, none of those words is predominant. In the second place, bearing

in mind that the average consumer rarely has the opportunity to study a mark closely and, therefore, only has an imperfect picture or recollection of it, it is unlikely that the consumer's imperfect picture of the mark will enable him or her to recall its word element. In that regard, the intervener also observes that the applicant's approach, which consists in regarding the words forming the verbal element of the mark sought as its dominant feature because they are visible, ignores both the overall impression given by the mark and the fact that the average consumer does not analyse a mark in detail and normally retains only an imperfect picture of the mark.

33 Secondly, as regards the arbitrary nature of the link between the mark sought and the goods, the intervener observes that the mark has no reference to the goods in Class 3 or any significance which could be related to them, and that the application for the Community trade mark does not cover goods or services connected with polo playing but goods completely unconnected to that sport.

34 Thirdly, the applicant's argument that, if it is not set aside, the Board's decision would have the effect of conferring on the intervener an unfair and unjustified monopoly of its polo player device is, according to the intervener, implicit recognition by the applicant that its horseman logo is similar to one of the intervener's earlier marks and that there exists a likelihood of confusion on the part of the public. The intervener submits that to refuse to register the later mark is thus entirely justified. The intervener argues also, in that regard, that the Board of Appeal correctly held that the applicant had failed to prove the use, for goods in Class 3, of other trade marks containing an element representing a polo player. In the first place, as regards the registration of United Kingdom trade mark No 1 558 682, the intervener observes that the registration followed its consent. In the second place, as

regards Community trade mark No 980 995, the intervener refers to the Board of Appeal's decision which pointed out that that sign depicts two polo players.

35 The intervener observes, fourthly, that in its assessment of the likelihood of confusion the Board of Appeal took account, correctly, of the fact that the intervener's mark has become even more distinctive through use and the fact that the intervener has developed, in relation to goods in Class 3, a family of trade marks which relate conceptually to the game of polo.

36 The conclusion that the goods covered by the Community trade mark application are identical or similar to the goods covered by the intervener's earlier marks is, in its submission, a further factor which supports the existence of a likelihood of confusion. The intervener recalls in that regard the Court's case-law according to which a lesser degree of similarity between the goods and services covered may be offset by a greater degree of similarity between the marks, and vice versa (Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819).

Findings of the Court

37 It must first of all be recalled that Article 8(1)(b) of Regulation No 40/94 provides that, upon opposition by the proprietor of an earlier trade mark, the mark applied for is not to be registered if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected. Under Article 8(2)(a)(ii) of Regulation No 40/94, 'earlier trade marks' means trade marks registered in a Member State with a date of application for registration which is earlier than the date of application for registration of the Community trade mark.

38 As is clear from consistent case-law, the global appreciation of the likelihood of confusion must, as regards the visual, phonetic or conceptual similarity of the conflicting signs, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components (see, by analogy, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23, and *Lloyd Schuhfabrik Meyer*, cited above, paragraph 25).

39 Next, it must be recalled that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (Case T-6/01 *Matratzen Concord* v *OHIM — Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 33).

40 It is in the light of those considerations that the Board of Appeal's assessment of the likelihood of confusion between the conflicting marks must be examined.

41 It is important, first, to point out that, by taking the figurative element as the dominant element of the trade mark sought, the Board of Appeal did not in the least ignore, in the comparison of the two signs from the visual point of view, the verbal element of that mark. In making that comparison the Board of Appeal expressly took into account the way in which the words were written. The applicant's allegation that the Board of Appeal did not consider the mark sought as a whole is therefore manifestly unfounded. The Board of Appeal also correctly took the figurative element as the dominant element of the mark sought. It is certainly the polo player, that is to say the figurative element, which gives that mark its distinctiveness and which will be the most easily remembered by consumers. By

contrast, the verbal element of the mark sought, consisting of six words written in relatively small characters which are, because of their position in the roundel, particularly difficult to read, is negligible in the overall impression produced by that mark. In addition, the presence of the verbal element in the form of a roundel only emphasises the figurative element of that mark, with the result that the latter's dominance is strengthened.

42 Secondly, the applicant's argument that the reference made, in the contested decision, to the arbitrary nature of the mark takes no account of the fact that it is a mark of origin, identifying those products as originating from The Royal County of Berkshire Polo Club. In that regard, it must be observed that the Board of Appeal had observed in paragraph 31 of the contested decision, that the figurative element of the mark sought, taken as the dominant element of that mark, was arbitrary in relation to the goods for which that mark was sought. That observation is entirely correct, since it cannot be denied that the concept of the sport of polo deriving from the mark sought has no connection with the goods in Class 3 for which registration of the Community trade mark was applied for. It follows that the question whether the contested decision took account of the fact that it was a mark of origin is irrelevant to the resolution of this dispute.

43 Thirdly, the Court considers that the argument that, were it not to be annulled, the Board of Appeal's decision would have the effect of according the intervener an unfair and unjustifiable monopoly over the polo player device, and would enable it to prevent any later application containing a similar logo cannot be accepted. It must be observed, in that regard, that the Board of Appeal was entirely correct in maintaining that the device of a polo player is intrinsically highly distinctive in relation to the Class 3 goods for which registration of the mark is sought and which are currently covered by the earlier UK registration because, in relation to those products, the device of a polo player is an image with high imaginative content. Such a device must be regarded as arbitrary for the goods in question and deserves to be protected against subsequent applications depicting confusingly similar devices.

Indeed, the advantage of the legal regime of the Community trade mark lies precisely in the fact that it enables holders of an earlier trade mark to oppose the registration of later marks which take unfair advantage of the distinctiveness or repute of the earlier trade mark. Hence, far from according an unfair and unjustifiable monopoly to the proprietors of an earlier mark, that regime enables those proprietors to protect and exploit the substantial investment made to promote their earlier mark.

44 Finally, the applicant's argument that the Board of Appeal substituted for the test of likelihood of confusion between the marks in question a test based on the assumed degree of similarity between the marks must also be rejected as unfounded. The existence of a likelihood of confusion between the marks in question was correctly established by the Board of Appeal, since it took into account, in its analysis, all the factors relevant to the circumstances of the case: the partial identity or similarity of the goods, the visual and conceptual similarities between the signs, the enhanced distinctiveness, both inherent and through use, of the polo player device in the intervener's trade mark and the existence of a family of trade marks belonging to the intervener linked to the concept of polo for goods in Class 3.

45 It follows that, since the applicant has not shown that the Board of Appeal infringed Article 8(1)(b) of Regulation No 40/94, this plea in law must be rejected.

The intervener's application based on Article 134(3) of the Rules of Procedure of the Court of First Instance

The intervener's arguments

46 In its response, the intervener seeks, first of all, the alteration of the Board of Appeal's decision in so far as it rejected the opposition as regards the following goods mentioned in the application for registration of the Community trade mark: 'bleaching preparations and other substances for laundry use; polishing, scouring and abrasive preparations'. The intervener submits, in effect, that those goods can be assimilated to soaps, which are covered by the intervener's trade mark registered in the United Kingdom under No 657 864. The similarity of those goods with soaps arises from the fact that they can both be used for domestic cleaning purposes, may share the same channels of trade, may be located in the same aisles (if sold in a supermarket) and may be used in conjunction with one another, and companies which manufacture that type of product offer a complete range of cleaning products. Consequently, in view of the similarity between soaps and the abovementioned goods, as well as the likelihood of confusion which exists between the two trade marks, the Board of Appeal should have rejected the application for registration for all the goods covered, including 'bleaching preparations and other substances for laundry use; polishing, scouring and abrasive preparations'.

47 The intervener also criticises the contested decision for not having upheld the opposition on the basis of its other trade marks. It criticises, more particularly, paragraph 44 of the contested decision in that it states that the differences between the trade mark applied for and the intervener's other earlier marks, set out in paragraph 5 above, outnumbered the phonetic and visual similarities. In that regard, the intervener notes the Board of Appeal's finding that four of those other earlier

marks do not depict a polo-playing horseman and that in the remaining four earlier marks, that is to say those which do depict a polo player, the dominant element is the word 'polo'.

48 The intervener submits that the trade mark applied for and the other earlier marks are similar and that there exists a likelihood of confusion on the part of the public concerned. In the first place, the mark sought evokes the concept of polo as a sport, and it is therefore that concept which is the basis of the mark. It is precisely that concept which is evoked by the other marks, with the result that the other earlier marks and the mark applied for are conceptually very similar. In the second place, in view of the fact that the earlier marks are all particularly distinctive both inherently and through their use, as well as because, as regards the assessment of the likelihood of confusion, the average consumer is deemed to retain only an imperfect image of the mark, it is likely that consumers will confuse the mark sought with another mark within the intervener's family of marks.

49 The intervener concludes that the Board of Appeal did not sufficiently examine the question of the conceptual similarity between the mark applied for and the other earlier marks and failed to rule on the question of the likelihood of confusion.

Findings of the Court

50 By asking the Court, first, to alter the Board of Appeal's decision in so far as it rejected the opposition concerning bleaching preparations and other substances for laundry use and polishing, scouring and abrasive preparations, and, secondly, to uphold the opposition for all the goods covered by the application for the

Community trade mark, on the basis both of the earlier trade mark registered in the United Kingdom under No 657 864 and of the other earlier trade marks, the intervener is making use of the opportunity afforded to it by Article 134(3) of the Rules of Procedure to seek, in its response, a form of order altering the decision of the Board of Appeal on a point not raised in the application.

51 In such a case, the other parties may, under Article 135(3) of the Rules of Procedure, within a period of two months of service upon them of the response, submit a pleading confined to responding to the form of order sought for the first time in the intervener's response. Neither OHIM nor the applicant made use of that opportunity. By contrast, at the hearing both the applicant and OHIM gave their views on the intervener's application. In that context, the applicant invited the Court to reject that application as unfounded. OHIM addressed only the part of the application concerning the rejection by the Board of Appeal of the opposition in respect of bleaching preparations and other substances for laundry use, and polishing, scouring and abrasive preparations. It pointed out that it shared, in that regard, the intervener's approach.

52 It must be noted, first of all, that, while it is true that most of the goods covered by the earlier figurative trade mark registered in the United Kingdom under No 657 864 are used solely as beauty or personal hygiene products, the same cannot be said for soaps, which have a dual function. Even if soaps are used to wash the body and give it an agreeable scent or aspect, it is none the less true that, as the Board of Appeal failed to point out in paragraph 22 of the contested decision, they are also used as housekeeping products. In that respect they are comparable to bleaching preparations and other substances for laundry use, as well as to cleaning, polishing, scouring and abrasive preparations. It follows that a similarity exists between, on the one hand, soaps covered by the earlier figurative mark registered in the United Kingdom under No 657 864, and, on the other hand, bleaching preparations and other substances for laundry use, and polishing, scouring and abrasive preparations,

for which registration is applied for by the applicant. Taking account of that similarity, the likelihood of confusion found by the Board of Appeal extends also to bleaching preparations and other substances for laundry use and to polishing, scouring and abrasive preparations, with the result that the Board of Appeal's decision must be annulled in part inasmuch as it did not refuse the application for registration of the Community trade mark for those goods. Under Article 63 of Regulation No 40/94, it is for OHIM to take the measures entailed by such partial annulment.

53 In so far as concerns the intervener's application for the opposition to be upheld on the basis of its earlier trade marks other than that registered in the United Kingdom under No 657 864, it is appropriate to observe that such an application could, at the very most, lead to the same result as does the preceding paragraph, that is to say to the outright refusal of the application for the Community trade mark for the goods in Class 3. Since the intervener's application on that second basis has thus become devoid of purpose, it must be rejected.

Costs

54 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs, if they have been applied for in the successful party's pleadings. In this case, the applicant has been unsuccessful and OHIM has applied for costs against it. At the hearing, the intervener also applied for the applicant to be ordered to pay the costs. The fact that the intervener did not apply for costs until the hearing does not debar the Court from awarding them (Case 113/77 *NTN Toyo Bearing and Others* v *Council* [1979] ECR 1185, and the Opinion of Advocate General Warner at [1979] ECR 1212, 1274). The applicant must therefore be ordered to pay all the costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fifth Chamber)

hereby:

1. **Annuls the contested decision in so far as it allows the registration for the benefit of The Royal County of Berkshire Polo Club Ltd of the trade mark application for the following goods in Class 3: bleaching preparations and other substances for laundry use, and polishing, scouring and abrasive preparations;**

2. **Dismisses the remainder of the action;**

3. **Orders the applicant to bear its own costs and to pay those incurred by the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) and by the intervener.**

Vilaras Martins Ribeiro Jürimäe

Delivered in open court in Luxembourg on 21 February 2006.

E. Coulon M. Vilaras

Registrar President